

"Where no assignee exists, applicant should affirmatively state that fact." MPEP 1410.01. The rule does not require the Applicant to sign a verification to that effect or include such a statement in the oath or declaration. Applicant has discharged its obligations stating there is no assignee. Specifically, in the Response dated January 11, 2002 to the Office Action dated October 1, 2001 the applicant specifically and affirmatively stated:

As noted in the 37 C.F.R. §1.172 requires only that "A reissue oath or declaration...must be accompanied by the written assent of all assignees, if any..." (emphasis added). ***Please note that neither issued U.S. Patent No. 5,842,178 nor the present reissue application has been assigned. Since no assignee exists***, no assent is required under the Rules. (emphasis added)

The rejection of claims 1 - 44 under this section is thus respectfully requested to be withdrawn.

Notwithstanding the foregoing, if the Examiner maintains the objection the applicant will provide a verification of the applicant stating the applicant owns the entire interest in the subject application because no assignment was ever made. The applicant is currently out of the country and unavailable to execute said verification in conjunction with the filing of this amendment. Applicant respectfully submits this objection is overcome and should be withdrawn.

Objection Under 37 CFR 1.173

The Office Action objected to the application under 37 CFR 1.173 as being based on a specification that is defective for lack of written description and enablement. For the

reasons set forth below addressing the rejections of claims 3-44 under 35 U.S.C. 112, this objection should be withdrawn.

Rejections Under 35 U.S.C. 251 and 37 CFR 1.175

Claims 1 – 44 are rejected under 35 U.S.C. 251, 37 C.F.R. §1.175 as being based on a defective Declaration. In response, the applicant will submit in due course a supplemental declaration overcoming this objection. Applicant is currently out of the country and unavailable to execute documents. Accordingly, this objection should be withdrawn.

Claims 3-44 are rejected under 35 U.S.C. 251, 37 C.F.R. §1.175 as being based on a defective Declaration. For the reasons set forth below addressing the rejections of claims 3-44 under 35 U.S.C. 112, this objection should be withdrawn.

Objections to Specification Under 35 U.S.C. 112

The specification is objected to for failure to meet the written description and enablement requirements of 35 U.S.C. 112, first paragraph. For the reasons set forth below addressing the rejections of claims 3-44 under 35 U.S.C. 112, first paragraph this objection should be withdrawn.

Rejection of Claims 3-44 Under 35 U.S.C. 112, first paragraph

Written Description

Claims 3 – 44 are rejected under 35 U.S.C. §112, first paragraph as containing

subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Applicant traverses this rejection. It is respectfully submitted that the language of the specification complies with the written description requirement. If a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate written description requirement is met. *In re Alton*, 37 U.S.P.Q. 2d 1578, 1584 (Fed. Cir. 1996).

In the first instance the examiner "bears the initial burden... of presenting a prima facie case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q. 2d 1443, 1444 (Fed. Cir. 1992). Insofar as the written description requirement is concerned, that burden is discharged by "presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims." *Wertheim*, 541 F.2d at 263, 191 U.S.P.Q. at 97. If the specification contains a description of the claimed invention, albeit not *in ipsius verbis* (in the identical words), then the examiner, in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient. *Id.* at 264, 191 U.S.P.Q. at 98; *In re Alton*, 37 U.S.P.Q. 2d 1578, 1583 (Fed. Cir. 1996). It is not necessary that the application describe the claim limitations exactly,... but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations. *In re Wertheim*, 191 U.S.P.Q.

90, 96 (C.C.P.A. 1976.

The specification contains a description of the claimed invention, even though the word "click" does not appear *ipsis verbis* in the specification. Use of hypertext links and clicking same were well known in the art, as set forth below, and as such the Examiner can not provide a satisfactory basis for stating that one of ordinary skill in the art would not consider the description sufficient. Therefore the Examiner can not meet the necessary burden of proof to sustain the rejection. Even if the burden is met, it is completely rebutted by the showing by the Applicant that persons of ordinary skill in the art would recognize from the disclosure that appellants had possession of the claimed invention.

As expressed by the Applicant in the January 11, 2002 Response, the Examiner incorrectly characterizes as conjectural the applicant's use of phrases such as "e-mail *could be* configured as HTML pages," "hypertext links *can be* embedded in the quotation" and "the option *may be* to request that an email purchase order be sent" (emphasis added). Applicant reiterates that the textual intent of the terms "could," "can" and "may" equates to "is able to" as a statement of positive ability, or as one way of accomplishing the invention, not dubious possibility. Indeed, if applicant had stated "In one embodiment, hypertext links are embedded in the quotation," that would have given the same teaching without the words "could" or "can." Since such a teaching is well known, the use of "could" or "can" does not change the substance of the disclosure.

The statements as to the manner in which the invention may be carried out provide "considerable direction and guidance in the specification" because "all of the methods

needed to practice the invention were well known." *In re Wands*, 8 U.S.P.Q. 2d 1400 (Fed. Cir. 1988).

The creation of hypertext links and email requests were known in the art at the time of making the invention, thus requiring little explanation. The Taylor reference cited by the Examiner is proof that hypertext links and email requests were well known in the art at the time of making the invention (see copyright notice "© 1995.."). Applicant further submits pages from the techweb.com encyclopedia which indicate in pertinent part that hypertext is "[a] linkage between related text... ***originally coined by Ted Nelson in the mid-60s*** as a method for making the computer respond to the way humans think and require information" (emphasis added). The techweb.com reference goes on to state:

[h]ypertext is the foundation of the World Wide Web. Links embedded within the Web pages are addresses to other Web pages either stored locally or on a Web server anywhere in the world.

Page 96 of the Taylor reference clearly shows that the use of the term "click" in the context of hypertext links was not only well known in the art as of at least as early as 1995 but was actually considered trite:

TIP: Try to avoid using "Click here" and similar labels for hypertext tags; cool Web pages come from creative, meaningful and unobtrusive integration of links into the text. Taylor p. 96.

Adequate description under the first paragraph of 35 U.S.C. 112 does not require literal support for the claimed invention... [r]ather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an applicant had possession of the concept of what is claimed. *Ex parte Parks*, 30 U.S.P.Q. 2d 1234,

1236-37 (B.P.A.I. 1993). Further, M.P.E.P. §2164(b) states: "[A]s long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied (emphasis added). Here, where "clicking" on hypertext links was so well known in the art as to be considered trite, the references in the specification to the use of hypertext links is more than sufficient to satisfy the written description requirement of Section 112, first paragraph. In summary, one of skill in the art given a teaching that hypertext links can be embedded in e-mail, would certainly know how to do that.

Thus, it is respectfully requested that the rejection on the basis of §112, first paragraph (written description) be withdrawn.

Enablement

Claims 3 – 44 are further rejected under 35 U.S.C. §112 first paragraph for inadequate enablement.

The substance of the rejection on the basis of nonenablement is that since the application did not meet the written description requirement, it must not be enabled. Applicant traverses this rejection.

It has been consistently held that the first paragraph of 35 U.S.C. 112 requires nothing more than objective enablement. *Staehein v. Secher*, 24 U.S.P.Q. 2d 1513, 1516 (B.P.A.I. 1992). In satisfying the enablement requirement, an application need not teach, and preferably omits, that which is well-known in the art. *Id.* How such a

teaching is set forth, whether by the use of illustrative examples or by broad descriptive terminology, is of no importance since a specification which teaches how to make and use the invention in terms which correspond in scope to the claims must be taken as complying with the first paragraph of 35 U.S.C. 112 unless there is reason to doubt the objective truth of the statements relied upon therein for enabling support. *Id.*

Since the application meets the written description requirement, and the description in the specification of the use of hypertext links in the present invention is sufficient to enable one skilled in the art to make the invention, the Applicant respectfully submits the enablement rejection is overcome and should be withdrawn.

PRIOR ART REJECTIONS

It is respectfully submitted that none of the cited prior art systems involve an interactive vendor-customer exchange or real bidding of item pricing. Thus the invention as claimed is not anticipated, nor obvious. The arguments below respond to rejections under 35 U.S.C. §§ 102 and 103.

Rejection Under 35 U.S.C. 102

Claim 2 is rejected under 35 USC §102 (e) as unpatentable over the cited patent to Cameron et al.

Applicant traverses this rejection. Invalidity for anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference. *Scripps Clinic & Research Found. V. Genentech Inc.*, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991)

Cameron et al. does not disclose each and every limitation of claim 2. Namely, Cameron et al. neither discloses nor suggests a method including the step of communicating to a centralized filter means from a plurality of sellers sale information indicating items offered for sale.

Cameron et al. teaches a computer system for entry of orders by a telephone clerk in a catalog sales context. Cameron et al. discloses a “system including system storage for storing offer information, and for storing electronic reproductions of offer sources corresponding to the offer information.” (Cameron et al Abstract). Cameron et al discloses five (5) distinct “modules”: a summary module (col. 8 line 17 – col. 9 line 46); a name capture module (col. 9 line 47 – col. 10 line 43); a billing module (col. 10 line 45 – col. 13 line 24); an order capture module (col. 13 line 26 – col. 17 line 58) and a shipping module (col. 17 line 60 - col. 18 line 62). There is no module for “offer” capture, and none of the modules contain any teaching or disclosure of “communicating... from a plurality of sellers sale information”. Rather, the “offers” of Cameron et al. are stored in a searchable database (Cameron et al. col. 2 lines 40 – 50 and col. 3 lines 3 - 7) and revealed to a user by virtue of search criteria input by the user (Cameron et al. col. 2 line 51 – col. 3 line 2 and col. 16 lines 49-53). Hence, there is no step of “communicating to a centralized filter means from a plurality of sellers sale information” as required by claim 2 of the instant invention. Indeed, Cameron et al. specifically states that “[t]he method includes the step of storing offer information relating to the offers, and also for storing electronic reproductions of the offer sources”. (Col. 3 lines 5-7).

Furthermore, claim 2 indicated in the original issued patent that the filter means is

a centralized filter means, as discussed in the application from page 6, line 12 to line 60 and in Figure 2. Centralized filter means as disclosed in the application involves means for applying rules to both buyer and seller defined factors at a single location. Cameron et al. discloses only a filter means which filters source search criteria from the buyer.

Therefore, since Cameron et al. do not teach or suggest each and every limitation of claim 2 the rejection should be withdrawn. Applicant submits that claim 2 is in allowable form.

Rejections Under 35 U.S.C. 103

Claim 1

Claim 1 is rejected under 35 U.S.C. §103(a) as unpatentable over the cited patent to Cameron et al in view of Shoquist et al. Claim 1 recites a system for engaging in commercial transactions comprising filter means for accepting filter conditions from buyers and sellers; a plurality of buyers for communicating RFQs to said filter means; a plurality of sellers for communicating quotes to said filter means in response to said RFQs, said filter means including means for determining, based upon said filter conditions, which sellers should receive RFQs from a buyer, and which quotes should be received by the buyer.

Applicant traverses this rejection. As stated hereinabove, Cameron et al disclose a system in which seller data is stored in a database wherein a user searches said database and information is displayed to the user based on search criteria entered by the user. Cameron et al neither disclose nor suggest "a plurality of sellers for communicating

quotes to said filter means” as claimed in claim 1. Nor do Cameron et al disclose or suggest a plurality of sellers for communicating quotes to said filter means in response to said RFQs.

Shoquist et al. teach a system for the creation and maintenance of documents within a company through access to vendor and item data stored on a mainframe (column 1, line 64 – column 2, line 8; column 9, lines 62 – 63). The Shoquist et al. system manipulates and provides forms for item requisitions and resultant documents (see Abstract). A requisition is entered into the system and requisitioned items are matched with vendors that are pre-listed in the mainframe database by item category. A vendor is chosen from the listing based on the information in the database, and a purchase order is written. Status reports of requisitions and purchase orders are generated in the system to provide current information to the buyer. Shoquist does not teach, suggest or relate to the invention of claim 1 because it does not involve a plurality of buyers for communicating RFQs to said filter means; a plurality of sellers for communicating quotes to said filter means in response to said RFQs, said filter means including means for determining, based upon said filter conditions, which sellers should receive RFQs from a buyer, and which quotes should be received by the buyer. Nor do Shoquist et al disclose or suggest “a plurality of sellers for communicating quotes to said filter means” as claimed in claim 1.

Applicant submits that the Examiner has impermissibly combined the cited references. Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented

invention. *ATD Corp. v. Lydall, Inc.*, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998). There must be a teaching or suggestion in the prior art to look to particular sources of information, to select particular elements and to combine them in the way they were combined by the inventor. *Id.*

Here, Cameron et al does not disclose or suggest the concept of a plurality of sellers for communicating quotes to a filter. Therefore there is no motivation to look to other prior art references, especially to Shoquist et which is in a completely different art area, namely document procurement, and combine them with Cameron et al. to fit the parameters of the invention of claim 1.

Even combining the references cannot render the invention of claim 1 obvious because the combination does meet all the limitations of claim 1. Since neither Cameron et al nor Shoquist et al disclose or suggest any communication from sellers, let alone to a centralized filter, the combination of references can not supply these elements.

Accordingly, it is respectfully submitted that the rejection of claim 1 is overcome and that claim 1 is in condition for allowance.

Claims 3 – 6, 8 – 13, 15, and 18 – 44

Claims 3 – 6, 8 – 13, 15, and 18 – 44 are rejected under 35 U.S.C. §103(a) as unpatentable over the cited patent to Cameron et al in view of Taylor.

Applicant respectfully traverses the rejection of these claims.

Applicant incorporates by reference the arguments hereinabove relating to the scope and applicability of Cameron et al.

Taylor discusses the availability of several web-based directories. Page 214, particularly noted in the Office Action, describes an indexed commercial web site provided by Open Market that has the capability of searching 3,500 entities by business name. Taylor simply discloses that HTML was available to those of skill in the art at the time the present application was filed. Taylor therefore shows that the §112 rejections should be withdrawn, but there is no suggestion in Taylor to use HTML links in combination with filtering means to facilitate an efficient ordering system by matching buyers to sellers. Therefore, Taylor neither teaches nor suggests the claimed subject matter.

Combining Cameron et al and Taylor results in a web-based directory in which seller data is stored in a database wherein a user searches said database and information is displayed to the user based on search criteria entered by the user. The combination of Cameron et al and Taylor does not suggest the claimed subject matter of claim 3 (and therefore dependent claims 4-6, 8-13, 15 and 18-19) which claims a method for effectuating a purchase between a buyer and a seller selected from a plurality of sellers over a computer communications network, comprising the steps of providing over said network a hypertext link containing page including information of each of a plurality of sellers' offers and at least one hypertext link for said buyer to make a response; displaying said hypertext link containing page to said buyer; and sending a purchase request by said buyer to said selected seller by clicking on said hypertext link. Claim 3 relates to an interactive method for effectuating a purchase between buyer and a plurality of sellers rather than a buyer simply searching a database. Claim 3 includes the limitation

of "providing over said (computer) network a hypertext link containing page including information of each of a plurality of sellers offers" from which a buyer may select a single seller from whom to purchase. In contrast, the Cameron et al. reference discloses a telephone operation of a catalog sales business, not business-to-business transactions, nor are multiple sellers contacted and invited to make genuine offers to the buyer. Although Cameron et al. uses the reference "offer," the "offer" in the present invention is communicated from a seller over a computer network, clearly distinct from mere storage of a listing in a catalog. Thus, it is believed that claim 3 and all claims dependent thereon are distinct over all known prior art and are patentable.

Likewise claims 20-30 are allowable because the combination of Cameron et al and Taylor neither discloses nor suggests the subject matter of claim 20 (and therefore dependent claims 21-30) which claims a method of effectuating a purchase between a buyer and a seller over a computer communications network, comprising the steps of providing credit information of said buyer to a seller; providing over said computer communications network, from one or more sellers to said buyer, a hypertext link containing page including information of each seller's offer and at least one hypertext link for said buyer to make a response; displaying each said hypertext link containing page to said buyer; selecting one of said one or more sellers; sending a purchase request by said buyer to the selected seller by clicking on said hypertext link; and fulfilling said purchase upon receipt of said purchase request from said buyer. Claim 20 includes the limitations, not found or suggested in the cited references, of "providing over said computer communication network, from one or more sellers to said buyer..." and of the buyer

“selecting one of said one or more sellers,” neither being disclosed or suggested in any cited reference. Therefore, it is respectfully submitted that claim 20, and claims 21 – 30 dependent therefrom, are all patentable.

Similarly claims 31-41 are allowable because the combination of Cameron et al and Taylor neither discloses nor suggests the subject matter of claim 31 (and therefore dependent claims 32-41) which claims a computerized system for effectuating a purchase between a buyer and a seller selected from a plurality of potential sellers over a communications network, comprising means for each of said plurality of potential sellers to provide a hypertext link containing page including information of at least one offer and at least one hypertext link for said buyer to make a response; means for said seller to transmit said at least one hypertext link containing page to said buyer, means for said buyer to receive and display said at least one hypertext link containing page; and means for said buyer to click on a selected one of said at least one hypertext link to send a purchase request in response to said offer.

In the same way claims 42-44 are allowable over the rejection because the combination of Cameron et al and Taylor neither discloses nor suggests the subject matter of claims 42, 43 or 44. Claim 42 claims a method of enabling a buyer to purchase an item over a communications network from a remote system, the method comprising the steps of selecting a hypertext link indicative of a desire to place an electronic purchase order; in response to said step of selecting, transmitting at least one electronic purchase order to a seller; and in response to said step of transmitting, providing credit information of the buyer maintained at said remote system to complete

the purchase of said item. Claim 43 claims a method of enabling a buyer to purchase an item over a communications network from a remote system, the method comprising the steps of selecting a hypertext link indicative of a desire to place an electronic purchase order; in response to said step of selecting, verifying that the buyer has sufficient credit to make the intended purchase; and in further response to said step of selecting, transmitting electronically credit verification information and at least one purchase order to the seller. Claim 44 claims a method of purchasing an item over a communications network from a system that facilitates the selling of goods and services comprising the steps of prestoring credit information of a buyer, and in response to selection of a hyperlink by a buyer indicating a purchase, matching said prestored information with said buyer to complete said purchase.

Accordingly, the rejection of claims 3-6, 8-13, 15 and 18-44 are overcome and applicant respectfully submits the claims are in allowable form.

Claims 7, 14 and 16 – 17

Claims 7, 14 and 16 – 17 are rejected under 35 U.S.C. §103(a) as unpatentable over the cited patent to Cameron et al. and Taylor in view of Ginsburg.

Applicant respectfully traverses the rejection of these claims.

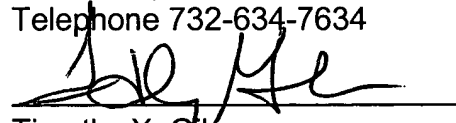
Applicant incorporates by reference the arguments hereinabove relating to the scope and applicability of Cameron et al. and Taylor. Applicant respectfully submits that because each of claims 7, 14 and 16-17 are dependent on claims that are allowable the rejection of these claims should be withdrawn.

In view of the foregoing remarks, it is respectfully submitted that all claims pending are allowable. Therefore, reconsideration and allowance are respectfully requested.

August 23, 2002

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Timothy X. Gibson', is written over a horizontal line.

Timothy X. Gibson
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hypertext

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Hypertext is the foundation of the World Wide Web. Links embedded within Web pages are addresses to other Web pages either stored locally or on a Web server anywhere in the world. Links can be text only, in which case they are underlined, or they can be represented as an icon of any size or shape.

The hypertext concept was originally coined by Ted Nelson in the mid-1960s as a method for making the computer respond to the way humans think and require information. The terms "hypertext" and "hyperlink" are used synonymously. See [hyperlink](#).

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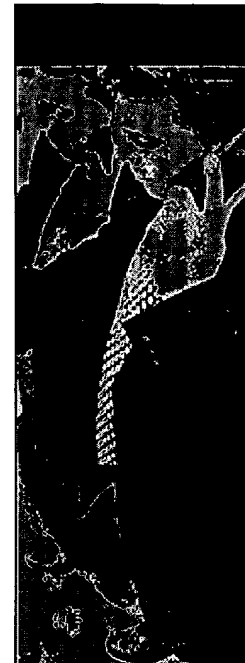
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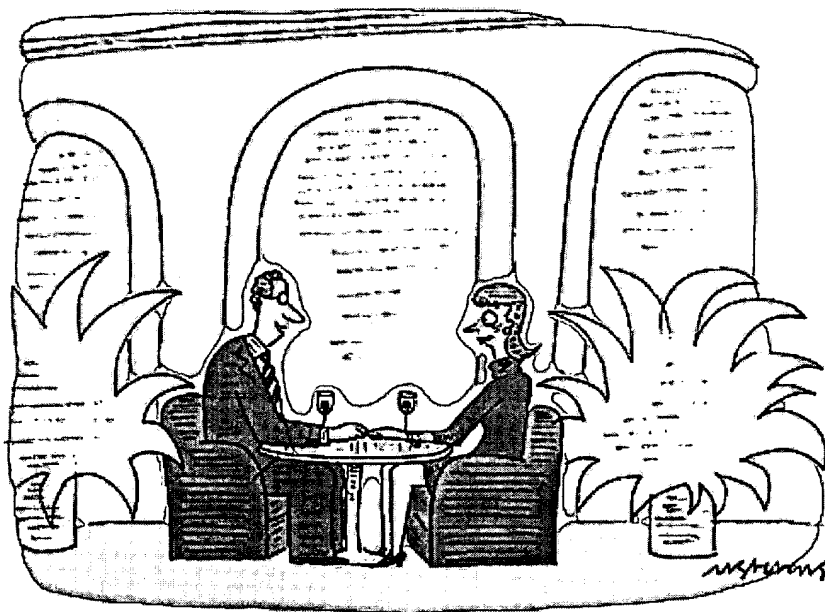
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hyperlink

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